

**REMARKS**

The Office Action mailed November 18, 2003 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-9 and 11-19 were pending in the application. No claims have been amended or canceled by this response, while new claims 20-22 have been added. Therefore, claims 1-9 and 11-22 are pending in the application and submitted for reconsideration.

This amendment adds, changes or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

**§ 112 REJECTIONS**

Claims 1-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite allegedly because handguns are available in various sizes and shapes. Applicant respectfully traverses this rejection.

A rejection of a claim under 35 U.S.C. § 112 as broader than the enabling disclosure is a first paragraph enablement rejection and not a second paragraph definiteness rejection. See MPEP 2164.08. Further, claims are not rejected as broader than the enabling disclosure under 35 U.S.C. § 112 for noninclusion of limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious. *In re Skrivan*, 427 F.2d 801, 806, 166 USPQ 85, 88 (CCPA 1970). See also, MPEP 2164.08. In evaluating the scope of the claims, one does not look to the claims but to the specification to find out how to practice the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558, 220 USPQ 303, 316-17 (Fed.

Cir. 1983). In the present case, the fact that handguns are available in a variety of shapes and sizes is well known to one of ordinary skill in the art. Additionally, paragraph [0018] of the present application explicitly teaches that the “[r]etaining cavity 13 is shaped and sized to the particular handgun being carried,” while Figure 1 illustrates at least one preferred embodiment of the invention. Applicant submits that one of ordinary skill in the art reading the instant application would understand how to make and use a cavity “configured and dimensioned to hold a handgun therein,” and therefore the claims are neither indefinite nor broader than the enabling disclosure.

**§ 103 REJECTIONS**

Claims 1-5 and 9-14 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,116,306 to Zander (“the Zander ‘306 patent”). Claims 1-5, 9-13 and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,674,664 to Simon (“the Simon ‘664 patent”). Claims 1-5, 9-12 and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,806,742 to Mott et al. (“the Mott ‘742 patent”). Claims 1-6 and 10-13 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,216,932 to Wu (“the Wu ‘932 patent”). Claims 1-8, 10-13 and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,544,745 to Fomorca (“the Fomorca ‘745 patent”). Applicant respectfully traverses these rejections.

The Examiner alleges that “[i]t would have been an obvious matter of design choice to size the retaining cavity to hold a handgun since such a modification would have involved a mere change in the size of a component.” However, “[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a

motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Regarding the applied art in the present case, the Zander '306 patent is directed to a clavicle strap joined to a posture training device provided with weight pockets for holding weights; the Simon '664 patent and the Wu '932 patent are directed to backpacks or backpacks; the Mott '742 patent is directed to a pack with shoulder straps for holding a rifle; while the Fomorca '745 patent is directed to a case for exchanging audible and written messages and includes cassette pockets for holding audio cassettes, a battery pocket for storing batteries, and a detachable recorder pocket for carrying an audio cassette recorder. None of these references provide motivation for a cavity "configured and dimensioned to hold a handgun therein." The motivation is in the instant application. It would not be 'simply a matter of design choice to size the retaining cavity to hold a handgun' *without* the benefit of the teachings of applicant's specification. Thus, none of the cited references singly or in combination render the present claims obvious.

#### New Claims

Claims 20-22 are newly presented for the Examiner's review and consideration. Support for these claims can be found in paragraphs [0018] and [0019] of the specification. No new matter has been added.

#### CONCLUSION

In view of the foregoing, it is respectfully submitted that the pending claims are in condition for allowance. Entry of this amendment and an early notice to this effect is earnestly solicited. Should there be any questions regarding this application, the Examiner is invited to contact the undersigned at the number shown below.

If any fees are deemed necessary, including any fees required under 37 C.F.R. § 1.136 for any necessary extension of time to make the filing of the attached documents timely, please charge or credit the difference to Deposit Account No. 50-2228. Further, if these papers are not considered timely filed, then a request is hereby made under 37 C.F.R. § 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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